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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,881	05/15/2006	Hilmar Bischoff		5797

35969 7590 04/19/2007  
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EXAMINER
RAHMANI, NILOOFAR

ART UNIT	PAPER NUMBER
1625	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/19/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/531,881

Applicant(s)

BISCHOFF ET AL.

Examiner

Niloofer Rahmani

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4-13 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-12 is/are allowed.
- 6) ☒ Claim(s) 1,4,5,13 and 16-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 1, 4-13, 16-18 are pending and claims 2-3, 14-15 are cancelled in the instant application.

2. ***Priority***

This application is filed on 05/15/2006, which is a 371 of PCT/EP03/11619, filed on 10/21/2003, which claims priority of GERMANY 102 50 687.6, filed on 10/31/2002.

3. The rejection of claims 1, 4-13, 16-18 under 35 U.S.C. 112 second paragraph for "R<sup>2</sup>" is withdrawn in view of the applicant's amendment in paper dated on 03/19/2007.

4. The rejection of claims 1, 4-13, 16-18 under 35 U.S.C. 112 first paragraph, as failing to comply with the written description requirement for "treating or preventing a disorder controlled by inhibition of the cholesterol ester transfer protein (CETP)" is withdrawn in view of the applicant's amendment and argument in paper dated on 03/19/2007.

5. The rejection of claims 1, 4-6, 11-18 under 35 U.S.C. 102(b) over Pettibone et al., Nishida et al, Suzuki et al., Frobels et al., Sassa et al. is withdrawn in view of the applicant's amendment and argument in paper dated on 03/19/2007.

6. The rejection of claim 18 under 35 U.S.C. 112, first paragraph for the term "preventing" is maintained for reason of record. Applicants agree to delete the term "preventing", solely to expedite the prosecution of the

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present application, and without prejudice to Applicant's right to pursue them in one or more continuation, divisional or continuation-in-part applications. It is examiner's position to remind the applicants to also delete the term "preventing" from claim 18.

7. The rejection of claims 1, 4-5, 13, and 16-18 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement is maintained for reason of record. Applicants argue that it is disclosed that the claimed compounds can be prepared by synthetic procedures described in examples 1-151. It is examiner's position that the enablement rejection is for use the claimed invention not how to make the claimed invention.

Applicants argue that " the active compounds according to the invention cause a lowering of the LDL cholesterol level in the blood together with a simultaneous increase in the HDL cholesterol level." It is examiner's position that the specification lacks enablement the linkage between lowering of the LDL cholesterol and the treatment of stroke, Alzheimer's disease and obesity.

Applicants also argue that nonetheless, the examiner further alleges that one skilled in the art would have to engage in an undue amount of experimentation to use the instantly claimed invention commensurate in scope with the claims. It is examiner's position that as the claims go every where from treating hypolipoproteinemia to treating Alzheimer's, then if this

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is scope of the claims, this would be undue experimentation for the treat all these diseases.

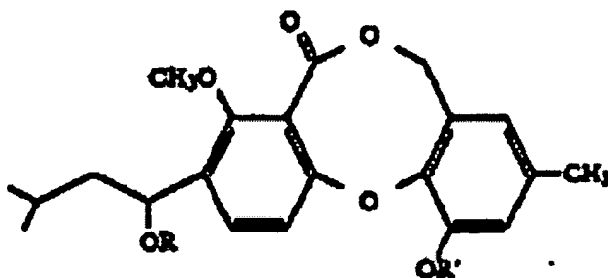
**THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**8. Allowable Subject Matter**

Claims 6-12 are patentable over pettibone et al., US 5,198,463. The reference teaches

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, wherein R being H

and R' being CH<sub>3</sub> instead of the R<sup>8</sup> being -O-C(O)-R<sup>16</sup>, -O-C(O)-NR<sup>17</sup>R<sup>18</sup>, -C(O)-OR<sup>19</sup>, -NR<sup>20</sup>-C(O)-R<sup>21</sup> or -NR<sup>22</sup>-C(O)-NR<sup>23</sup>R<sup>24</sup> of the instant application. Therefore, the claims are free of prior art.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Niloofar Rahmani whose telephone number is 571-272-4329. The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Mckenzie, can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NILOOFAR RAHMANI

04/11 /2007

NR

MARGARET D. SEAMAN

PRIMARY EXAMINER

GROUP 1625